UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,016	05/01/2001	Diego Gastaldi	A-6396	5647

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EXAMINER
BULLOCK JR, LEWIS ALEXANDER

ART UNIT	PAPER NUMBER
2127	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _01 October 2004_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-5,7-28,30,32-35 and 37_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-5,7-28,30,32-35 and 37_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _01 May 2001_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1.   Claims 2, 9-17 and 33-35 are rejected under 35 U.S.C. 112, first paragraph, as

failing to comply with the enablement requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to enable one skilled in

the art to which it pertains, or with which it is most nearly connected, to make and/or use

the invention. The claims detail that the processor is located in a media services server

device and is configured to either receive a request for media presentation or receive

the subscriber identification from the media services client device. However, each of

the independent claims detail that the processor is located in a media services client

device, and configured to insert the subscriber identification information into the media

presentation during a vertical blanking interval of the presentation of the media

presentation. It would be impossible for one to make or use the invention with the

processor in both the client device and the service device at the same time. In addition,

the specification provides for the processor to be in either device, not in both.

Therefore, there is no support for the processor to operate in both devices.

2.   Claims 22-25 is rejected under 35 U.S.C. 112, second paragraph, as being

incomplete for omitting essential steps, such omission amounting to a gap between the

steps. See MPEP § 2172.01. The omitted steps are: the sending of the subscriber

identification information to the media services client device so that the client device can

insert the subscriber information into the media presentation, i.e. claim 26.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1, 3-5, 7, 8, 18-28, 30, 32-35 and 37 are rejected under 35 U.S.C. 103(a)

as being unpatentable over SETH-SMITH (U.S. Patent 4,890,319).

As to claim 1, SETH-SMITH teaches a media services device (subscription

television system), comprising: a memory (EEPROM) for storing subscriber

identification information (subscriber identification number / user specific information)

(col. 21, lines 2-10); and a processor (microprocessor) configured to receive the

subscriber identification information (user specific information) and a media presentation

(message sent with template), wherein the processor is configured to insert the

subscriber identification information (user specific information) into the media

presentation (message sent with template / copyright protected information) (col. 21,

lines 1-10), wherein the processor is located in a media services client device

(decoder), wherein the processor is configured to insert the subscriber identification

information (user specific information) into the media presentation (message sent with

template / copyright protected information) (col. 21, lines 1-10; col. 24, lines 62-67; col.

26, lines 12-28) wherein the subscriber identification information is invisible to a viewer

of the media presentation (col. 4, lines 56-59). SETH-SMITH teaches the template/flag

is stored in the vertical blanking interval of the media presentation (col. 7, lines 22-30;

col. 8, lines 52-63; col. 10, lines 33-46). It is obvious to one skilled in the art that since

the template/flag is completed by inserting the data that the insertion is performed

during the vertical blanking interval of the presentation.

As to claim 3, SETH-SMITH teaches the processor is located in a media services

client device (decoder), wherein the processor is configured to receive the subscriber

identification information (user specific information / address information / client

addressed message) from an in band pathway (within the media presentation) delivered

from a media services client device (col. 21, lines 1-10; col. 24, lines 62-67; col. 26,

lines 12-28).

As to claim 4, SETH-SMITH teaches the processor is located in a media services

client device (decoder), wherein the processor is configured to receive the subscriber

identification information (user specific information / address information / client

addressed message) inputted from a remote control device (key pad / bar code reader)

(col. 24, lines 15-21; col. 20, lines 37-39; col. 1, line 30 - col. 2, line 2; col. 19, lines 38-

63).

As to claim 5, SETH-SMITH teaches the processor is located in a media services

client device (decoder), wherein the processor is configured to receive the subscriber

identification information (user specific information / address information) (col. 21, lines

1-10; col. 24, lines 62-67; col. 26, lines 12-28). SETH-SMITH also teaches the user

indicates which tiers he wished to view to the broadcaster by using a signal that is not

the media presentation signal (col. 10, lines 51-55). It would be obvious that this signal

is an out-of-band signal and that the subscriber identifier must be inherent sent and

used in order to identify the correct subscriber.

As to claim 7, SETH-SMITH teaches the subscriber identification information is

bar-code inputted information (col. 19, lines 53-63). It is obvious to one skilled in the art

that bar-code information on the bar-code chip cannot be rewritten without generating

another bar-code chip and is therefore write protected. It is also obvious to one skilled

in the art that since the information is guarded and used for correlation between the

decoder and the secret serial number that the information is write protected.

As to claim 8, SETH-SMITH teaches the processor is located in a media services

client device (decoder), wherein the processor is further configured to de-multiplex,

decrypt, and decompress the subscriber identification information and the media

presentation in the media services client device (col. 6, lines 52-64).

As to claim 18, SETH-SMITH teaches the processor is further configured to

insert the subscriber identification information in to the media presentation to enhance

tracing copying of the media presentations (col. 25, lines 3-9).

As to claim 19, SETH-SMITH teaches a method for inserting subscriber

identification information into media presentations, the method comprising steps of:

receiving subscriber identification information (subscriber identification number / user

specific information) (col. 21, lines 2-10); storing the subscriber identification information

in memory (col. 21, lines 2-10); receiving a subscriber request for a media presentation

(via the user indicates which tiers he wished to view to the broadcaster by using a signal

that is not the media presentation signal / via the user using the keypad via the buy

button) (col. 10, lines 51-55) (col. 24, lines 15-21; col. 20, lines 37-39; col. 1, line 30 -

col. 2, line 2; col. 19, lines 38-63); and inserting the subscriber identification information

into the media presentation requested by the subscriber, wherein the inserting of the

subscriber identification information occurs at the media services client device

(decoder), wherein the media services client device inserts the subscriber identification

information into the media presentation (col. 21, lines 1-10; col. 24, lines 62-67; col. 26,

lines 12-28) wherein the subscriber identification information is invisible to a viewer of

the media presentation (col. 4, lines 56-59). SETH-SMITH teaches the template/flag is

stored in the vertical blanking interval of the media presentation (col. 7, lines 22-30; col.

8, lines 52-63; col. 10, lines 33-46). It is obvious to one skilled in the art that since the

template/flag is completed by inserting the data that the insertion is performed during

the vertical blanking interval of the presentation.

As to claim 20, SETH-SMITH teaches the receiving steps occur at a media services client device (decoder) (col. 24, lines 15-21; col. 20, lines 37-39; col. 1, line 30 - col. 2, line 2; col. 19, lines 38-63; col. 21, lines 2-10)

As to claim 21, SETH-SMITH teaches the media services client device (decoder) receives the subscriber identification information and the request for the media presentation from a remote control device (key pad / bar code reader) (col. 24, lines 15-21; col. 20, lines 37-39; col. 1, line 30 - col. 2, line 2; col. 19, lines 38-63; col. 21, lines 2-10).

As to claims 22-26, SETH-SMITH teaches the user indicates which tiers he wished to view to the broadcaster by using a signal that is not the media presentation signal (col. 10, lines 51-55). It would be obvious that this signal is an out-of-band signal and that the subscriber identifier must be inherent sent and used in order to identify the correct subscriber. Therefore, since the broadcaster, i.e. media services server device, knows the tiers and directs messages to individual subscribers, the broadcaster stores the subscriber identifier, i.e. the subscriber's name and the tiers its requesting and sends the message with the subscriber identifier to the subscriber for viewing.

As to claim 27, SETH-SMITH teaches the storing step occurs at the media services client device (decoder) (col. 21, lines 2-10).

As to claim 28, SETH-SMITH teaches the user indicates which tiers he wished to view to the broadcaster by using a signal that is not the media presentation signal (col. 10, lines 51-55). It would be obvious that this signal is an out-of-band signal and that the subscriber identifier must be inherent sent and used in order to identify the correct subscriber. Therefore, since the broadcaster, i.e. media services server device, knows the tiers and directs messages to subscribers, the broadcaster stores the subscriber identifier, i.e. the subscriber's name and the tiers its requesting.

As to claim 30, SETH-SMITH teaches the step of receiving the media presentation from the media services server device (broadcaster / transmitter) (abstract; col. 6, lines 52-64).

As to claim 32, SETH-SMITH teaches the media services server device transports the media presentation to the media services client device as a compressed and encrypted media stream (col. 6, lines 52-64).

As to claims 33-35, SETH-SMITH teaches the media services server device (broadcaster) inserts the subscriber identification information (address packets) into an encrypted and compressed subscriber identification information portion of the compressed and encrypted media stream (col. 22, lines 9-30).

As to claim 37, SETH-SMITH teaches the subscriber identification information is bar-code inputted information (col. 19, lines 53-63). It is obvious to one skilled in the art that bar-code information on the bar-code chip cannot be rewritten without generating another bar-code chip and is therefore write protected. It is also obvious to one skilled in the art that since the information is guarded and used for correlation between the decoder and the secret serial number that the information is write protected.

Response to Arguments

5. Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection.
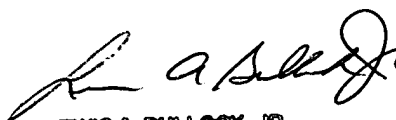
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lewis A. Bullock, Jr. whose telephone number is (571) 272-3759. The examiner can normally be reached on Monday-Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 5, 2005

LEWIS A. BULLOCK, JR.
PRIMARY EXAMINER